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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,569	09/26/2005	Thomas Sonnenrein	10191/3587	5517
26646	7590	02/14/2008	EXAMINER	
KENYON & KENYON LLP			TO, TUAN C	
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NEW YORK, NY 10004				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/516,569		SONNENREIN ET AL.	
	Examiner		Art Unit	
	TUAN C. TO		3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-33 is/are pending in the application.
- 4a) Of the above claim(s) 26-30, 32, and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-25 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 17-24 are rejected under 35 U.S.C. 102 (a) as being anticipated by Rigo et al. (US 20020049535A1).

Regarding claims 17-19, Rigo et al. discloses a system/method for performing a telematics service on a vehicle (paragraph 0022, lines 1-8) comprising:

subdividing the telematics service into partial telematics functionalities (see figure 4, the telematic service is divided into the automobile side with telematics functionalities (see paragraph 0047), and data center side with telematics functionalities (see figure 4).

Rigo et al. inherently discloses the telematics service is divided into functionalities that are critical with respect to time. In figure 2, paragraphs 0043 and 0047, the vehicle system (10) includes various input functionalities associated with the onboard automated telematics (32). The telematic unit (32) connects wirelessly to carry voice and data between the unit (32) and a wireless communication protocol adapter (201) at the off-board computing facility or central station (22). Although, Rigo et al.

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does not mention partial telematics functions that are not critical with respect to time, Rigo et al. mention telematic unit and the function of carrying voice between said unit and the central station. This shows that the cited reference to Rigo et al. inherently discloses "partial telematics functions that are not critical with respect to time".

Rigo et al. inherently discloses that the telematics service is divided into functionalities that is critical with respect to time (see figure 4, from the automobile side, a plurality of service functions are performed: speech, graphic, navigation, cell-phone, etc).

Rigo et al. inherently discloses the act of "establishing a communication connection between a server and the vehicle telematics unit located in the vicinity of the vehicle" (figure 1, the communication is established between a server and the vehicle telematics unit via the wireless service (16),

Rigo et al. inherently discloses the act of "executing in the server the partial telematics functionalities that are not critical with respect to time (figures 1-3, a plurality of service providers are wirelessly connected with the vehicle telematics unit 32),

Rigo et al. inherently discloses the act of "executing in the telematics unit (32) the partial telematics functionalities that are critical with respect to time" (figure 2, paragraphs 0043 and 0047, telematics functionalities that are executed in a motor vehicle via an on-board telematics unit 32).

As to claim 20, in Rigo et al. the partial telematics functionalities that are critical with respect to time are executed in the vehicle telematics unit (32), and the partial

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telematics functionalities that are not critical with respect to time are implemented by the server at a service provider (figure 1, paragraph 0040).

As to claim 21, Rigo et al. further teaches that the partial telematics functionalities that are critical with respect to time comprise the communication with a control unit located in the vehicle (see figure 3, a communication is established with the vehicle telematics unit 32 via the vehicle control unit 42).

As to claims 22-24, Rigo et al. teaches a remote diagnosis service provider (figure 1, auto repair service (30) is a remote diagnosis service provider that provides a remote diagnosis). Because the vehicle user can access the auto repair service (30) via the Internet (20), the remote diagnosis is inherently implemented through a diagnosis protocol.

Rigo et al. inherently teaches: "the telematics service includes a remote diagnosis of the vehicle, the remote diagnosis being implemented through a diagnosis protocol, and wherein the diagnosis protocol is implemented in the server".

Claim 31 is rejected under 35 U.S.C. 102 (a) as being anticipated by Saito et al. (US 20020044049A1).

Saito et al. directs to a vehicle system/method for performing a remote diagnosis of a vehicle, comprising: "activating the remote diagnosis by establishing a communication connection between a server and a data terminal located in the vicinity of the vehicle". In Saito et al., a communication connection is established, between the mobile terminal (111) and the server (100) via the network (103) (Saito et al., figure 1).

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A vehicle diagnosis is remotely performed by transmitting the vehicle data collected from the vehicle (104) (See Saito et al., figure 1) to server computer (100).

Saito et al. further discloses "transmitting diagnosis commands from the server to the control unit via the data terminal" (see figure 1).

In Saito et al., the results of execution of the diagnosis commands are done via the car navigation system (109), and that said diagnosis commands from said car navigation system (109) is transmitted to the server computer (100) (see figure 13) via the mobile terminal (111).

The server (100) transmits results of evaluation to mobile terminal (111) after evaluating the answers in the server (Saito et al, figure 11; page 1, paragraph 0009, abnormal analysis process is done at the server of a service company after the abnormal data received from mobile terminal via the Internet 103).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claim 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rigo et al. (US 20020049535A1) and in view of Robinson et al. (US 6647323B1).

Rigo et al. teaches a remote diagnosis service provider, however, Rigo et al. fails to include that the diagnosis protocol includes KWP2000.

Robinson et al. teaches a vehicle system/method in which the diagnosis protocol includes KWP2000 (column 2, lines 24-28).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system/method as taught by Rigo et al. to include the diagnosis protocol of Robinson et al so that the vehicle controller software is capable of interfacing with a communication network that comprises the KWP2000, and therefore a remote development, diagnostic, and other software tool can communicate with the communication network to access vehicle process variables and data in the memory of the vehicle controller.

Response to Arguments

Applicant's arguments filed 11/26/2007 have been fully considered but they are not persuasive.

The current invention directs to a method for performing a telematics service on a vehicle in which telematics service are provided and divided into partial partial telematic functions that are critical with respect to time and partial telematic functionalities that are not critical with respect to time, and that these partial functionalities are subdivided between server and data terminal.

The applicant's claims would not be patentable over the cited reference to Rigo et al. for the following reasons:

Although the cited reference to Rigo et al. does not include partial telematics functionalities that is not critical with respect to time, and patial telematics functionalities that are critical with respect to time, Rigo et al. directs to a wireless interactive voice-actuated mobile telematics system including on-board telematics unit in a motor vehicle connects wireless communication with the Internet. An interactive voice net off board station is connected via Internet to communicate wirelessly with the on-board unit. In Rigon et al., the telematic service on a vehicle is provided (see paragraph 0047). The telematics services are divided into the partial telematics functions that are performed using the telematics unit (32) that connects wirelessly to carry voice and data between the unit (32) and wireless communication protocol adapter (201). The telematics services are also divided into the partial telematics functions that are performed at the central station.

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Claim 31 is rejected as being anticipated by Saito et al. (US 20020044049A1).

The examiner has realized the cited reference to Saito et al. identically discloses each and every limitations of claims 31. The rejection of claim 31 has been revised in order to clearly address each limitation of the claim (see body of the rejection)

Claim 25 has been rejected under 103(a) as being unpatentable over Rigo et al. (US 20020049535A1) and in view of Robinson et al. (US 6647323B1). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the cited reference to Rigo et al. is modified by substituting the diagnosis protocol of Robinson et al so that the vehicle controller software is capable of interfacing with a communication network that comprises the KWP2000, and therefore a remote development, diagnostic, and other software tool can communicate with the communication network to access vehicle process variables and data in the memory of the vehicle controller.

For that reason, the claimed invention would not be patentable over the cited prior art.

Conclusions

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan C To whose telephone number is (571) 272-6985. The examiner can normally be reached on from 8:00AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on 571-272-6878.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Tuan C To/

Primary Examiner of Art Unit 3663/3600